

REMARKS

Claims 13-19 are pending in the application. By this Amendment, claim 13 has been amended, and claim 16 has been cancelled. No new matter has been added. It is respectfully submitted that this Amendment is fully responsive to the Office Action dated November 6, 2008.

Claim Rejections under 35 U.S.C. §112, First Paragraph:

Claims 13-19 stand rejected under 35 U.S.C. §112, first paragraph, in item 5 of the Action as failing to comply with the written description requirement. More specifically, the Examiner takes the position in item 5, pages 2 and 3 of the Action, that the specification does not support a direct transmission from the terminal of the forwarder to the communication device, but rather from the terminal of the forwarder to the IM server and then to the communication device, as discussed on page 7 of the present specification. This rejection is respectfully traversed. Independent claim 13 has been amended to correspond with the specification, such that claim 1 reads “transmitting an instant message including identification information of the terminal of the forwarding destination from the terminal of the forwarder to a communication device via the instant message server.” Accordingly, withdrawal of this rejection is respectfully requested.

As to the Merits:

As to the merits of this case, the Examiner maintains the following rejection:

claims 13-19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Li et al. (US-2003/0182428 hereinafter, Li) in view of Dorenbosch et al. (US-2002/0173308 hereinafter, Dorenbosch).

This rejection is respectfully traversed.

Independent claim 13 has been amended to include the features of dependent claim 16 concerning transmitting the instant message from the terminal of the forwarder to the terminal of the forwarding destination without intervening the communication device when the user of the forwarding destination is logged in the instant message server.

It is submitted that the Examiner's reliance on paragraphs [0020] through [0027] of the Dorenbosh reference for teaching these claimed features, as indicated on page 7, lines 14-18 of the Action lacks merit.

More specifically, as discussed in paragraph [0023] and as shown in Fig. 4, when the mobile subscriber 12 is logged on the IM system 10, the instant message sent from the

conventional subscriber 14 is first delivered to the IM proxy 24 and then it is forwarded to the mobile subscriber 12.

Further as shown in Fig. 5 of the Dorenbosch reference and as discussed in paragraph [0024], when the mobile subscriber 12 temporarily travels outside the coverage area of the mobile network 26, the instant message is first routed to the IM proxy 24 and then the IM proxy 24 attempts to deliver the message in subscriber 12.

As such, it is respectfully submitted that the Dorenbosch reference fails to teach the features of claim 13 regarding *transmitting an instant message including identification information of the terminal of the forwarding destination from the terminal of the forwarder to a communication device via the instant message server, when the user of the forwarding destination is not logged in the instant message server; ...*

transmitting the instant message from the terminal of the forwarder to the terminal of the forwarding destination via the instant message server without intervening the communication device when the user of the forwarding destination is logged in the instant message server,

In other words, in the present claimed invention, when the user of the forwarding destination is not logged into the instant message server, the instant message is forwarded to a communication device via the instant message server and the instant message includes identification information in the terminal of the forwarding information device. However, if the

forwarding destination is logged in the instant message server, the instant message is transmitted to the terminal of the forwarding destination via the instant message server without intervening the communication device.

In contrast, in Dorenbosch, the instant message is sent from the conventional subscriber 14 to the IM proxy 24 regardless of whether the mobile subscriber 12 is logged or is not logged in the instant message server (out of the coverage area).

In addition, it is also respectfully submitted that the primary reference of Li fails to forward the instant message to the terminal of the forwarding destination without intervening a communication device when the user of the forwarding destination is logged in the instant message server and transmitting the instant message to a communication destination via the instant message server when the user of the forwarding destination is not logged in the instant message server.

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

Application No.: 10/809,889

Response
Attorney Docket No.: 042089

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

A handwritten signature in black ink, appearing to be 'TEB', is written above the printed name of the attorney.

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